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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,322	12/12/2003	Chih-Lung Chang	3304.2.101	6011

21552 7590 06/01/2005

MADSON & METCALF  
GATEWAY TOWER WEST  
SUITE 900  
15 WEST SOUTH TEMPLE  
SALT LAKE CITY, UT 84101

EXAMINER
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PURVIS, SUE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/735,322

**Applicant(s)**

CHANG ET AL.

**Examiner**

Sue A. Purvis

**Art Unit**

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 6-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 22 February 2005.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Kreckel et al. (US Patent No. 6,491,781 B1).

Applicant admits on pages 1 and 2 of the instant specification that an image is applied to an article via an image-transfer medium. The medium disclosed in Figure 1(a) includes a transparent substrate (11) and a transferable material (12) formed on the substrate surface. Figure 1(b) shows a transfer medium with various images (or letters) for transfer, when a word such as "PRIMAX" is transferred to an article, a hollowed transferable material is created with a specific pattern vacant.

The admitted prior art does not teach transferring onto a light transmissible surface as required by the claim.

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Kreckel teaches that transferring an image graphic onto an article having a light transmissible surface is known. (Col. 8, lines 28-50.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made based on the teachings of Kreckel to use the transferable medium disclosed in the admitted prior art on an article with a light transmissible surface.

Regarding claim 2, official notice is taken that in order to transfer the material as is done in the admitted prior art, pressure is applied to the transfer medium by means of a stamping tool.

Regarding claim 3, the transferable material along with the transparent substrate is adhered to the article until the substrate is removed.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Kreckel as applied to claim 1 above, and further in view of Suss (US Patent No. 6,059,914).

The admitted prior art in view of Kreckel does not disclose a continuous layer of transferable material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made that a continuous layer of transferable material is an option, because as shown in Suss, using a continuous layer is known to a skilled artisan. (See Suss, Col. 2, lines 6-15.)

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Kreckel as applied to claim 1 above, and further in view of Williams et al. (US Patent No. 6,610,386 B2).

The admitted prior art in view of Kreckel does not disclose a dot pattern of transferable material.

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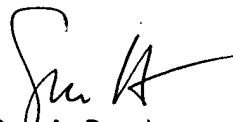
It would have been obvious to one having ordinary skill in the art at the time the invention was made that a dot pattern is within the purview of the artisan, because Williams teaches it is known in the art to use a dot pattern on transferable medium.

**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis  
Primary Examiner  
Art Unit 1734

SP  
May 28, 2005